

## REMARKS

### I. Status of the Claims

Further to this Amendment, claims 24, 27-49, and 51-76 are currently pending. Claims 27-33, 38-48, 52-73, and 76 stand as withdrawn from consideration by the Examiner. Claims 24, 34-37, 49, 51, 74, and 75 stand rejected. Independent claims 24, 49, 72, 74, and 75 have been amended. Support for these amendments can be found in the specification and claims as originally filed, such as, for example, page 18 of the specification. Therefore, there is written description support.

### II. Arguments

The Examiner has rejected claims 24, 34-37, 49, 51, and 74-75 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,880,076 ("*Vermeer*"). Office Action at page 3.

The Examiner indicates that *Vermeer* teaches a shower gel comprising sodium coconut isethionate (5-10 wt%), sodium ether lauryl sulfate (2-5 wt%), coconutamidopropyl betaine (8-15 wt%), isopropyl palmitate (0.5-1 wt%), and water. *Id.* The Examiner asserts that although *Vermeer* fails to teach the specific amount of ester as instantly claimed, it would have been obvious to optimize the dose range of *Vermeer's* compound by routine experimentation. *Id.* The Examiner states that the motivation to optimize the dose range comes from the reasonable expectation of success one would have in achieving "optimal hair conditioning and emulsifying or dispersment properties" in the personal product composition. *Id.* at 4. The Examiner also indicates that as *Vermeer* teaches a similar composition as claimed, the "limitation

of 'the composition being transparent with turbidity being less than 100 NTU' is rendered obvious over the teachings of *Vermeer*." *Id.* Applicants respectfully traverse for at least the following reasons.

To establish a *prima facie* case of obviousness, the Examiner must:

make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention.

M.P.E.P. § 2142, 8th Ed., Rev. 6 (September 2007). "The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. *Id.* In addition, according to MPEP § 2143.02, there must be a reasonable expectation of success in modifying the prior art in order to support a *prima facie* case of obviousness.

Applicants respectfully submit that such reasons are not present in the rejection of record at least because the prior art relied upon by the Examiner, when considered as a whole, fails to disclose or suggest a detergent and conditioning cosmetic composition comprising an ester from 1.2 to 8% by weight, the composition being transparent with turbidity being less than 100 NTU, and the composition comprising no pearlescent or opacifying agents as recited in amended claims 24, 49, 74, and 75 and all claims dependent thereon. In addition, Applicants submit that one of ordinary skill in the art would have had no reasonable expectation of success in modifying the composition as disclosed by *Vermeer* in order to obtain the composition as instantly claimed.

**A. Not Obvious to Remove The Ethylene Glycol Distearate From The Composition of *Vermeer***

Applicants submit that one of ordinary skill in the art would not have had any expectation of success in removing the ethylene glycol distearate in the shower gel composition disclosed in *Vermeer* in an attempt to obtain a composition as recited in instantly amended claims 24, 49, 74, and 75. The composition as recited in the instantly amended claims comprises no opacifier or pearlescent agents. The shower gel as disclosed by *Vermeer* in Example 34 contains ethylene glycol distearate. (*Vermeer*, column 67, lines 40-55), which *Vermeer* discloses as a suspending agent and as an opacifier and pearlescent agent. *Vermeer* at column 28, lines 46-52 and column 31, lines 40-45. Applicants submit that it would not have been obvious to one of ordinary skill in the art to have removed the ethylene glycol distearate from the composition of *Vermeer* in order to obtain the instantly claimed composition. Rather, Applicants submit that one of ordinary skill in the art would have understood the use of suspending agents to maintain insoluble conditioning agents, such as isopropyl palmitate, in suspension. See Specification, pages 2-3. Therefore, one of ordinary skill in the art would not have had a reasonable expectation of success in removing the ethylene glycol distearate in the composition of *Vermeer*, while still maintaining an even dispersion of the insoluble conditioning agents in the medium.

**B. Composition of *Vermeer* Not Similar to Instantly Claimed Composition and Therefore Transparency Not Obvious.**

Finally, the Examiner has provided no support or rationale for the conclusion that the composition of *Vermeer* containing such an opacifier/pearlescent agent would have the instantly claimed properties. The Supreme Court in *KSR v. Teleflex* 550 U.S. 398,

418 (2007), affirmed the fact that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (citing *In re Kahn*, 441 F.3d 977, 988 (CAFC 2006) (internal quotations omitted)); MPEP § 2142. In the instant case, Applicants respectfully submit that the Examiner has failed to support a *prima facie* case of obviousness, as the Examiner has failed to articulate any reasons as to why the composition of *Vermeer* **with a pearlescent agent such as ethylene glycol distearate**, would be expected to have the instantly claimed transparency. In addition, Applicants submit that the composition of *Vermeer* is not a “similar composition as claimed” in the instantly amended claims, as *Vermeer* contains an opacifying / pearlescent agent, and therefore the transparency limitation cannot be rendered obvious over the teachings of *Vermeer*.

**C. Not Obvious to Modify the Ester Concentration of *Vermeer***

Applicants submit that one of ordinary skill in the art at the time of the invention would also not have had a reasonable expectation of success in modifying the concentration of isopropyl palmitate disclosed in *Vermeer*, as one of ordinary skill would have expected the adjustment to negatively affect the stability of the shower gel.

As disclosed in the instant specification, insoluble conditioning agents (such as isopropyl palmitate) are known in the art to be difficult to maintain as an even dispersion. See Specification at 2. Therefore Applicants submit that one of ordinary skill in the art would not have had a reasonable expectation of success in increasing the amount of insoluble conditioning agent in a composition, as that increase would have been expected to negatively affect the stability of the composition, or require the

addition of dispersing or gelling agents to the composition. See *id.* at 3. As the addition of dispersing or gelling agents would prevent obtaining transparent or clear compositions, *id.*, this modification would be outside the scope of the presently amended claims.

*Vermeer* discloses the use of isopropyl palmitate in a shower gel (Example 34), at a concentration of 0.5% to 1%, which is outside the instantly claimed range of 1.2% to 8%. *Vermeer*, column 67. The Examiner indicates that *Vermeer* also discloses using an emulsifier/emollient in personal product and detergent compositions at a level of 0% to 10%, of which isopropyl palmitate is an example. *Id.* at column 30, lines 24-47. This listing also includes approximately 48 additional emulsifier/emollient compounds useful in such compositions. *Id.* Therefore, although *Vermeer* discloses a range of 0% to 10%, which encompasses the instantly claimed range, *Vermeer* only discloses isopropyl palmitate at a range outside of the instantly claimed range, and as submitted above, one of ordinary skill in the art would not have had a reasonable expectation of success in optimizing the concentration of isopropyl palmitate outside of that disclosed range.

Furthermore, one of ordinary skill in the art would not have had any expectation of success in increasing the amount of isopropyl palmitate in the shower gel composition of Example 34, modified to remove the ethylene glycol distearate. As explained above, insoluble conditioning agents are known in the art to be difficult to maintain as an even dispersion. See Specification at 2. Applicants submit that one of ordinary skill in the art would have expected that increasing the amount of isopropyl palmitate in a composition without ethylene glycol distearate, would have increased the

instability of the resulting composition. Therefore, this modification would not have been obvious to one of ordinary skill in the art.

For the above reasons, and those presented in the previous Office Action Responses, Applicants submit that the rejection of claims 24, 34-37, 49, 51, and 74-75 under 35 U.S.C. § 103(a) as being unpatentable over *Vermeer* is improper and should be withdrawn.

**D. Additional Modifications Also Not Obvious**

Finally, one of ordinary skill in the art, without the benefit of hindsight, would not have found it obvious to modify Example 34 of *Vermeer* to comprise a replacement for ethylene glycol distearate that was not an opacifier or pearlescent agent, would stabilize an increased concentration of isopropyl palmitate, and would allow the composition to be transparent with turbidity being less than 100 NTU, as instantly claimed. "A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art." MPEP § 2143.02 *Vermeer* discloses a large number of varied ingredients, and Applicants submit that one of ordinary skill in the art would not have had a reasonable expectation of obtaining predictable results in modifying Example 34 of *Vermeer*, to obtain a composition as instantly claimed, especially without the benefit or improper use of hindsight.

**III. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and allowance of the pending claims. The Examiner is invited to contact applicants' undersigned representative by telephone at (202) 408-4294 to discuss any outstanding matters. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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